

REMARKS

As a preliminary matter, Applicants point out that Applicants' election was with traverse, not without traverse as stated by the Examiner. In Applicants' response, Applicants requested that the Examiner reconsider the restriction of Groups I and II. Furthermore, Applicants requested that at least Invention # 3 and # 5 be combined since both invention groups contain the same core. Applicants did not strike out compounds (III) and (IV) in the present amendment in anticipation that the Examiner will reconsider the combination of these groups. If the Examiner maintains the restriction of Groups I and II, Applicants request that the Examiner rejoin Group II for consideration, upon allowance of the subject matter presently being prosecuted within this application.

Claim Objections:

Claims 2-7 were objected to as dependent upon a cancelled claim. Applicants respectfully point out that the claims were amended in a preliminary amendment dated December 2, 2003 such that the claims are now dependent from Claim 8. Accordingly, Applicants request that the Examiner withdraw the objection of Claims 2-7.

35 U.S.C. § 112 (1st Par.) Rejection of Claims 8-9 and 13-16

Claims 8-9 and 13-16 were rejected under 35 U.S.C. § 112 (1st Par.) as failing to comply with the written description requirement. In particular, the Examiner contends that alpha-2-delta ligands are not sufficiently described within the specification such that one of ordinary skill in the art would not appreciate Applicants' possession of the claimed invention, because there are alpha-2-delta ligands not yet known that are not in the possession of Applicants.

Applicants traverse the rejection of Claims 8-9 and 13-16 in that the Examiner failed to establish a *prima facie* case. In particular, the Examiner failed to provide reasons why a person skilled in the art would not recognize that the inventor was in possession of the invention as claimed in view of the disclosure of the application. MPEP § 2163.04 (I). There is a strong presumption that an

adequate written description of the claimed invention is present in the specification as filed. In re Wertheim, 541 F.2d 257, 262 (CCPA 1976). Consequently, rejection of an original claim for lack of written description should be rare. MPEP § 2163.03.

The test is whether the disclosure relied upon ‘reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subjected matter.’ Id. at 2163.02 (citing Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575 (Fed. Cir. 1985)). Applicants clearly set forth in the specification that Applicants claim a method of treating premature ejaculation by the administration of an alpha-2-delta ligand. Applicants support their invention by disclosing many alpha-2-delta ligand compound that may be administered for the treatment of premature ejaculation. Accordingly, the specification does sufficiently describe to one of ordinary skill in the art that Applicants’ were in possession of the claimed invention.

Applicants respectfully request that the Examiner reconsider the rejection of Claims 8-9 and 13-16, in light of the above comments.

35 U.S.C. § 112 (2nd Par.) Rejection of Claims 2-7

Claims 2-7 are rejected under 35 U.S.C. § 112 (2nd Par.) as failing to particularly point out and distinctly claim the subject matter that Applicant regards as their invention. The Examiner points out that Claim 2 is dependent upon a cancelled claim and, therefore, is not drawn to any method.

As discussed above, under the Claim Objection section, Claims 2-7 were amended via a Preliminary Amendment and are dependent from Claim 8, which is directed to the treatment of premature ejaculation. Accordingly, Applicants request that the Examiner reconsider the rejection of Claims 2-7.

35 U.S.C. § 102(e) Rejection of Claims 2-7

Claims 2-7 are rejected under 35 U.S.C. § 102(e) as anticipated by WO02/085839 (hereinafter “‘839”). The Examiner contends that the ‘839 reference teaches a method of treating neurodegenerative disorders comprising the claimed compounds. The Examiner points out that, since there is not

therapeutic indication claimed in Claim 2, for example, the claim is interpreted to mean any method.

Applicants traverse the rejection of Claims 2-7 and, again, point out that Claims 2-7 depend from Claim 8, which is directed to the treatment of premature ejaculation. Accordingly, the '839 reference does not anticipate Claims 2-7. Applicants respectfully request, therefore, that the Examiner reconsider the rejection of these claims.

CONCLUSION

Having addressed all points and concerns raised by the Examiner, Applicants respectfully submit that the application is in condition for allowance and request an early and favorable action in this application.

Respectfully submitted,

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